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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,940	12/15/2003	John H. Kiekhaefer	6499-6	3705

7590 04/23/2004
Walter W. Duft
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EXAMINER

FUREMAN, JARED

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,940

Applicant(s)

KIEKHAEFER, JOHN H.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-11,15,16,24-26,30-32,34,37,38 and 91-95 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,9-11,15,16,24-26,30-32,34,37,38 and 91-95 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Receipt is acknowledged of the preliminary amendment and IDS, filed on 12/15/2003, which have been entered in the file. Claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 38, and 91-95 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 31, 92, and 93 are rejected under 35 U.S.C. 102(b) as being anticipated by Travioli (US 3,536,894, cited by applicant).

Travioli teaches a financial transaction card (credit card 24) that is transparent or translucent to human viewing yet detectable by automated card processing equipment (credit card acceptor 10) having near Infrared source/detector pairs each having a source (flash lamp device 70) and a detector (photodetecting elements, see column 3, lines 53-58) respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card (see figures 4, 5 and 6), comprising: a sheet of material that is translucent to human viewing (layer 34, for example); and a near Infrared light filter (center layer 26) applied to said material sheet, said filter providing sufficient card opacity relative to one or more near Infrared light wavelengths (see column 2, lines 56-

72) to render said card detectable (the card is detectable in that the coded information can be read) by said source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to remain visible to transparent or translucent light; wherein said filter is formed as a film secured to said material sheet (see figure 4); wherein said filter is a clear, light absorbing material providing the requisite light filtering properties (as shown in figure 4, the center layer 26 absorbs infrared light and prevents the infrared light from passing through the card) (see figures 1, 3, 4, 5, 6, 10, column 2 line 56 - column 3 line 4, and column 3 lines 16-61).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32, 34, 37, 91, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travioli in view of Bratchley (GB 2 229 189, cited by applicant).

The teachings of Travioli have been discussed above.

Travioli fails to teach wherein said filter is applied to said material sheet as a liquid coating; wherein said filter is made from a light absorbing dye material dissolved in a liquid coating material at a dye-to-coating weight ratio of between about 0.2-5.0%; wherein said liquid coating comprises a plastic resin-based coating material; wherein

said filter comprises a light scattering material; wherein said filter is formed from a light filtering material disbursed through all or a portion of said material sheet.

Bratchley teaches financial transaction card (credit card, see abstract) with a filter applied as a liquid coating; wherein said filter is made from a light absorbing dye material dissolved in a liquid coating material at a dye-to-coating weight ratio of between about 0.2-5.0%; wherein said liquid coating comprises a plastic resin-based coating material (a thermoset polymer matrix); wherein said filter comprises a light scattering material; wherein said filter is formed from a light filtering material disbursed through all or a portion of said material sheet (see page 3 line 29 - page 4 line 11, page 4 lines 15-19, page 4 line 26 - page 5 line 19, page 5 line 26 - page 6 line 2, page 6 lines 9-15, 22-32, and page 7 lines 3-28).

In view of Bratchley's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Travioli, wherein said filter is applied to said material sheet as a liquid coating; wherein said filter is made from a light absorbing dye material dissolved in a liquid coating material at a dye-to-coating weight ratio of between about 0.2-5.0%; wherein said liquid coating comprises a plastic resin-based coating material; wherein said filter comprises a light scattering material; wherein said filter is formed from a light filtering material disbursed through all or a portion of said material sheet, in order to allow the filter material to be easily modified (by changing the composition of the liquid coating) to provide the desired performance for the particular system in which the card is intended to be used.

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5. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Travioli as modified by Bratchley as applied to claim 32 above, further in view of Scantlin (US 3,987,725, cited by applicant).

Travioli as modified by Bratchley fails to teach wherein said liquid coating is applied to said material sheet by screen printing.

Scantlin teaches a financial transaction card (credit card 2) that includes a liquid mixture filter (ink) that is applied to a material sheet (of the credit card) by screen printing (see figures 1, 2, 17, 35, column 3 lines 2-16, 33-44, column 11, lines 1-18, and 26-37).

In view of Scantlin's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Travioli as modified by Bratchley, the filter being a liquid mixture that is applied to the material sheet by screen printing, in order to provide a very accurate means/method of placing the filter on the sheet (see column 3 lines 44+, of Bratchley).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 38, 94, and 95 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-11, 15, 16, 24-26, 30-42, 34, 37, 38, 32, and 31, respectively of copending Application No. 09/675,912 (hereinafter the '912 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 9-11, 15, 16, 24-26, 30-32, 34, 37, 38, 94, and 95, of the instant application, are somewhat broader versions of claims 1, 9-11, 15, 16, 24-26, 30-42, 34, 37, 38, 32, and 31, of the '912 application.

For example, claim 1 of the '912 application recites: a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet being transparent or translucent to human viewing; and a near Infrared light filter covering one of said upper or lower surfaces of said material sheet, said filter comprising light absorbing dye filtering means for providing sufficient card opacity relative to one or more near Infrared light wavelengths to render said card detectable by said

source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to remain transparent or translucent to visible light.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 16, 31, 94, and 95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11, 1, 2, and 2, respectively, of U.S. Patent No. 6,705,530 (hereinafter the '530 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 16, 31, 94, and 95, of the instant application, are somewhat broader versions of claims 1, 11, 1, 2, and 2 of the '530 patent.

For example, claim 1 of the '530 patent recites: a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs, each source/detector pair including a near Infrared light source and a near Infrared light detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet having an area that is at least minimally transparent or translucent to human viewing and located so as to span an optical pathway of one or more of said source/detector pairs when said card is

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positioned in said equipment for detection; and an Infrared light filter associated with said area, said filter providing sufficient opacity to near Infrared light to render said card detectable by said source/detector pairs and being arranged to block the optical pathways of all source/detector pairs spanned by said area, thereby triggering detection of said card, while still allowing said card to remain transparent or translucent to visible light in said area.

9. Claims 1, 9, 16, 24, 25, 31, 32, 34, and 91-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 16, 9, 1, 1, 1, 8, 1, 1, 1, and 1, respectively, of U.S. Patent No. 6,296,188 (hereinafter the '188 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 9, 16, 24, 25, 31, 32, 34, and 91-95, of the instant application, are somewhat broader versions of claims 1, 8, 9, 16, 9, 1, 1, 1, 8, 1, 1, 1, and 1 of the '188 patent.

For example, claim 1 of the '188 patent recites: a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet being transparent or translucent with respect to human visible light; and a near Infrared light

filter covering one of said upper or lower surfaces of said material sheet, said filter comprising a screen-printed coating of a light filtering powder dissolved in a clear liquid carrier at a powder-to-carrier ratio of about 0.2-5% by weight; said filter producing sufficient card opacity relative to one or more near Infrared light wavelengths to render said card detectable by said source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to transmit human visible light.

10. Claims 1, 10, 11, 15, 16, 26, 30, 31, and 93-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 1, 7, 10, 11, 17, 20, 1, 7, 10, and 1, respectively, of U.S. Patent No. 6,290,137 (hereinafter the '137 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 10, 11, 15, 16, 26, 30, 31, and 93-95, of the instant application, are somewhat broader versions of claims 1, 1, 7, 10, 11, 17, 20, 1, 7, 10, and 1 of the '137 patent.

For example, claim 1 of the '137 patent recites: A financial transaction card that is transparent to human viewing yet detectable by automated card processing equipment having near Infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of said card when said card is positioned in said equipment for detection and to detect said card by sensing an interruption of near Infrared light transmitted from said source to said detector due to the presence of said card, comprising: a substantially planar material sheet having upper and lower surfaces bounded by a continuous peripheral edge; said material sheet being

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transparent to human viewing; and a near Infrared light filter covering one of said upper or lower surfaces of said material sheet, said filter comprising filtering means for producing sufficient card opacity relative to one or more near Infrared light wavelengths to render said card detectable by said source/detector pairs by blocking near Infrared light emitted by said source from reaching said detector, thereby triggering detection of said card, while still allowing said card to remain transparent to visible light such that definable images can be viewed through said card.

Allowable Subject Matter

11. Claim 95 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and upon the filing of a terminal disclaimer.
12. Claims 1, 9-11, 15, 16, 24-26, and 30 would be allowable upon the filing of a terminal disclaimer.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: a financial transaction card, and a method of manufacturing a financial transaction card, that is transparent or translucent to human viewing yet detectable by automated card processing equipment, the card comprising a infrared light filter covering an upper or lower surface of the material sheet (or the filter being located on the card so that near Infrared light is filtered over all regions of the card), the filter producing sufficient opacity to near infrared light to render the card detectable by source/detector pairs and being arranged to block near infrared light emitted by the

source from reaching the detector, in combination with the other claimed limitations as set forth in the claims.

While transparent cards having infrared light filters were well known to those of ordinary skill in the art at the time of the invention (see for example Travioli US 3,536,894, cited by applicant), the known cards utilize the light filters to encode information at certain locations of a data recording area on the card, and therefore the light filters do not cover a surface of a material sheet. Thus, there is no motivation for one of ordinary skill in the art to modify such a known card to include the filter being arranged to cover an upper or lower surface of a material sheet, since this would prevent the card from carrying information encoded (by the presence or absence of the filter material at multiple locations on the material sheet) by the filter material.

While West (US 5,005,873, cited by applicant) teaches a card having a filter material (fluorescent material) covering the entire card, West fails to specifically teach the location of a source/detector pair. Since the system of West detects light emitted by the fluorescent material, this suggests that the source and detector are located on the same side of the card. Therefore, there is no motivation to modify the system as taught by West to include opposing sources and detectors with the card passing between the source and detector, even though it was known to those of ordinary skill in the art at the time of the invention to detect the presence of a card by passing the card between opposing sources and detectors (see for example, Liu et al (US 5,434,404, cited by applicant) figure 4 and column 8 lines 1-11, and Kurihara et al (US 4,950,877, cited by applicant) figures 1-2B and column 4 lines 11-17).

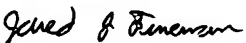
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ey Yamani et al (US 2004/0046034), Lasch et al (US 2004/0020992), and Toppan Printing CO. LTD. (JP 2003-145964 A) all teach transparent or translucent financial transaction cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jared J. Fureman
Examiner
Art Unit 2876

April 18, 2004